



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,578	12/17/2001	Thomas Schmidt	VJP-1030-US	1170

35938 7590 05/14/2010
BioTechnology Law Group
12707 High Bluff Drive
Suite 200
San Diego, CA 92130-2037

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
----------	--------------

1652

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

05/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DOCKETING@BIOTECHNOLOGYLAWGROUP.COM

Office Action Summary	Application No. 10/026,578	Applicant(s) SCHMIDT, THOMAS	
	Examiner HOPE A. ROBINSON	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34, 36, 37, 42-45 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-17, 32-34, 36-37, 42-45 and 47-51 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Status

1. Applicant's response to the Office Action mailed August 10, 2009 on February 10, 2010, is acknowledged.

Claim Disposition

2. Claims 1-34, 36-37, 42-45 and 47-51 are pending. Claims 16-17, 32-34, 36-37, 42-45 and 47-51 are under examination.

Claim Objection

3. Claims 16 and 37 are objected to because of the following informalities:

For clarity and precision of claim language, it is suggested that claim 16 is amended to read, "wherein each module binds at least one of a streptavidin ~~[[and]]~~ or a streptavidin mutein, wherein...".

For clarity and precision of claim language, it is suggested that claim 37 it is amended to read, "The fusion protein according to claim[[s]] 16...".

Correction of the above is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16-17, 32-34, 36-37, 42-45 and 47-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Skerra et al. Biomolecular Engineering, 16, 1999, pages 79-86, cited on IDS filed 12/6/02).

Skerra et al. teach a fusion protein comprising streptavidin binding domain such as Asn-Trp-Ser-His-Pro-Gln-Phe-Glu-Lys (page 81 of the reference) or Ala-Trp-Arg-His-Pro-Gln-Phe-Gly-Gly, see page 80 of the reference). On page 81 (right column) the reference discloses competitive binding with biotin. As the structure of the fusion protein is identical to the claimed structures, the fusion protein would inherently possess the binding affinity recited in the claims. Further, the recited distance is anticipated as it can be zero. Therefore the limitations of the claims are met by the reference.

Response to Arguments

5. The response filed has been received and entered. The rejections of record have been withdrawn, therefore, applicant's comments will not be addressed herein as they are moot. Note that a new ground of rejection has been instituted under 35 USC 102(b) for the reasons set forth above.

Conclusion

6. No claims are presently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOPE A. ROBINSON whose telephone number is (571)272-0957. The examiner can normally be reached on Monday-Friday 9:00-6:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hope A. Robinson/

Primary Examiner, Art Unit 1652